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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,392	07/29/2003	Joanne Hunt	84594MSS	6507

7590 09/19/2006

Patent Legal Staff
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EXAMINER

CAMERON, ERMA C

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/629,392	Applicant(s) HUNT ET AL.	
	Examiner Erma Cameron	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-18 is/are pending in the application.
 4a) Of the above claim(s) 2,3 and 14 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1,4-13 and 16-18 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The rejection of Claims 1, 4-13 and 16-18 under 35 U.S.C. 112, first paragraph (“particles, etc.”), is withdrawn because of the amendment filed 7/3/2006.

3. Claims 1, 4-13 and 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The description of the ink receiving layer as “porous, swellable, foamed” (as in line 2 of claim 1) does not appear in the specification as originally filed, and is therefore new matter.

The applicant is requested to cancel new matter.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The rejection of Claims 1, 4-13 and 16-18 under 35 U.S.C. 112, second paragraph, is withdrawn because of the amendment filed 7/3/2006.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 1060901.

'901 teaches forming a porous foamed base layer for an inkjet recording element by applying a hydrophilic polymer such as gelatin or PVA plus blowing agent to a support (4:4-37).

Response to Arguments

The applicant has argued in the 7/3/2006 amendment that the base layer of '901 is not an image receiving layer. However, there is no claim to an image receiving layer in the instant application. The claim is to an ink receiving layer, and the examiner's position is that by absorbing the ink solvent [0018], the base layer of '901 is acting as an ink receiving layer.

The applicant has also argued that the '901 base layer is not the top layer. However, the instant claims do not claim that the ink receiving layer is the topmost layer, only that the ink receiving layer is on top of the support layer.

8. Claims 1, 4 and 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dagan et al (6291127).

'127 teaches applying a hydrophilic ink receiving layer comprised of polymers foamed by blowing agents. The polymers include gelatin and PVA. The layer is applied to a cellulose paper base that has been impregnated with a condensation polymer (i.e resin-coated paper). The layer may also contain surfactants (3:5-11, 12:42-13:57).

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Response to Arguments

The applicant has argued in the 7/3/2006 amendment that '127 has a particular support substrate. However, the base is a resin-coated paper, thus meeting the limitations of claim 1 regarding the support.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5-12 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1060901.

'901 is applied here for the reasons given above.

'901 fails to teach the wt % of blowing agent, the presence of surfactants, plural simultaneous coatings or foaming by heat.

It would have been obvious to one of ordinary skill in the art to have optimized the wt% of the composition thru no more than routine experimentation.

Applying a plurality of coating solutions is a mere variation on typical coating practices.

'901 teaches that additives that are well known in the art may be added (4:36-37). This would be inclusive of surfactants.

Foaming by heating blowing agents is well known in the art.

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'901 fails to teach the blowing agents of claim 18. However, it is the examiner's position that any conventional blowing agents, such as those of claim 18, would be operational in the '901 process.

Response to Arguments

See the response above.

11. Claims 5, 7-12 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dagan et al (6291127).

'127 is applied here for the reasons given above.

'127 fails to teach the wt % of blowing agent or surfactant, plural simultaneous coatings or foaming by heat.

It would have been obvious to one of ordinary skill in the art to have optimized the wt% of the composition thru no more than routine experimentation.

Applying a plurality of coating solutions is a mere variation on typical coating practices.

Foaming by heating blowing agents is well known in the art.

'127 fails to teach the blowing agents of claim 18. However, it is the examiner's position that any conventional blowing agents, such as those of claim 18, would be operational in the '127 process.

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12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1060901 or Dagan et al (6291127), either taken in view of KR 2000-0063640.

'901 and '127 are applied here for the reasons given above.

'901 and '127 both fail to teach adding an acid to react with the blowing agent.

'640 teaches adding an acid that decomposes a foaming agent as a process to foam a PVA solution (see pages 7-9 of translation).

It would have been obvious to one of ordinary skill in the art to have used the acid foaming process of '640 in the '901 foaming process or '127 foaming process because '640 teaches that this is a conventional means of foaming a PVA solution.

Response to Arguments

The applicant has argued in the 7/3/2006 amendment that claim 13 is dependent on claim 1; thus no further arguments are presented.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ERMA CAMERON
PRIMARY EXAMINER

Erma Cameron
Primary Examiner
Art Unit 1762

September 14, 2006